

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application.

35 U.S.C. § 103

Claims 1-20 and 45-51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,309,301 to Sano (hereinafter "Sano") in view of U.S. Patent Application Publication No. 2003/0227473 to Shih et al. (hereinafter "Shih").

Sano discloses:

A game communication system enhancing and improving clarity of players perception of a game. The game communication system includes gaming machine units connected to each other through communication modules which are adapted to perform a communication procedure within the game communication system. Each of the gaming machine units includes communication units adapted to execute the communication procedure to ensure bi-directional communications among the gaming machine units, a performance unit performing a sound track for a corresponding gaming machine unit, and a synchronization data setting unit setting a synchronization data which is used to control operation timing of the performance unit. (Sano Abstract).

Regarding the Shih reference, Applicant notes that the Shih application (see U.S. Patent Application Publication No. 2003/0227473) was filed on May 2, 2001, which is nearly two months after the filing date of the present application. However, the Shih application claims priority to Provisional Application No. 60/201,163, filed on May 2, 2000. Thus, only the content of the Provisional Application pre-dates the filing of the present application. Accordingly, only the

content of the Provisional Application is prior art with respect to the present application.

Applicant notes that several portions of the Shih reference are not contained in the related Provisional Application. For example, the abstract is not contained in the Provisional Application. Additionally, paragraphs 0008-0010, 0022, 0040-0045, and 0047-0049 are not contained in the Provisional Application. Further, portions of paragraphs 0020 and 0046 are not contained in the Provisional Application. The portions of Shih mentioned above are not prior art with respect to the present application. The above-identified portions of Shih are merely examples of content not contained in the Provisional Application. There may be additional portions of Shih not mentioned above that are not contained in the Provisional Application.

In this response, when Applicant mentions the disclosure of the Shih reference, Applicant is referring to the content in the Provisional Application.

The Shih reference “relates to a computer method and system for incorporating user-personalized music and/or sound into a video game.” (See Shih Provisional Application, Technical Field). The Shih reference describes the operation of a music engine and the communication of information between a music engine and a video game via an interface. For example, Fig. 1 of Shih “is a flow chart describing the path of execution of a music engine” and Fig. 3 of Shih “is a class diagram describing the process of playing a sound file for a soundtrack or event.” (Shih Provisional Application, page 2). However, the Shih reference fails to disclose or suggest selecting stored audio tracks or creating a soundtrack containing the selected audio tracks.

As amended, **Claim 1** recites:

A game console, comprising:
a memory;
a processor coupled to the memory; and
a console application stored in the memory and executable on the processor, the console application configured to allow selection of a plurality of stored audio tracks by a user of the game console, wherein the game console is further configured to create a soundtrack containing the selected audio tracks.

Thus, claim 1 recites a game console that includes a console application that allows selection of multiple audio tracks by a game console user, and further allows creation of a soundtrack containing the selected audio tracks. As mentioned above, the Sano reference fails to disclose or suggest selecting audio tracks and further fails to disclose or suggest creating a soundtrack containing the selected audio tracks. The current Office Action agrees that Sano does not disclose creating a soundtrack. (See Office Action, page 2, paragraph 2a).

The Office Action relies on Shih for the deficiencies of Sano. In particular, the Office Action states "Shih discloses creating a plurality of sound files containing selected audio tracks (paragraphs 0004-0005 and 0010)". (Office Action, pages 2-3, paragraph 2a). Applicant notes that paragraph 0010 cited in the Office Action was not contained in the Provisional Application and, therefore, is not prior art with respect to the current application. Paragraphs 0004 and 0005 recite:

[0004] This invention solves the current problem with video games by providing a system and method that permits a user to incorporate user-personalized songs and sounds into a video game.

[0005] In one aspect of this invention, a method for incorporating user-personalized sound into a video game is provided, the method comprising: a) providing a music engine and an interface between the music engine and the video game, wherein the music engine is capable of providing a plurality of sound files to the video game, and further wherein the interface is capable of obtaining sound files from the music engine and presenting the sound files to the video game for playback; and b) sending a first signal from the video game to the interface to playback a first sound file from the music engine, thereby causing the music engine to send the first sound file to the video game for playback.

The disclosure of paragraphs 0004 and 0005 fail to make any reference to selecting “a plurality of stored audio tracks by a user of the game console”, as recited in claim 1. Further, nothing in paragraphs 0004 or 0005 suggest that a user of the game console selects multiple stored audio tracks. Additionally, the disclosure of paragraphs 0004 and 0005 do not make any reference to a game console “further configured to create a soundtrack containing the selected audio tracks.” The Shih reference fails to make any reference to creating a soundtrack containing the selected audio tracks. Shih is not concerned with the creation of soundtracks and, therefore, Shih makes no suggestion to create soundtracks containing the selected audio tracks. Accordingly, Applicant submits that the Shih reference fails to correct the deficiencies of Sano.

In the rejection of claim 1, the Office Action further states on page 3 “the concept of allowing a user to create a custom play list containing selected audio tracks would have been well known concept to a person of ordinary skill in the art at the time the invention was made.” Applicant disagrees with this statement and notes that the Office Action provides no support for this statement. Applicant submits that at the time the invention was made, creating a custom play list using a

game console was not well known to a person of ordinary skill in the art. Game consoles were traditionally limited to a specific set of functions that relate to one or more games. Existing game consoles were capable of playing pre-recorded sounds stored within a game application or a game cartridge. Since these game consoles did not lend themselves to customization, there was no thought of creating a soundtrack on a game console.

In rejecting claim 1, the Office Action also states on page 3 "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to configure the console application of Sano such that the console application of Sano is capable of creating a soundtrack containing the selected audio tracks in order to facilitate selection of specific list of audio tracks." Applicant disagrees with this statement and notes that the Office Action provides no support for this statement. As discussed in the preceding paragraph, Applicant submits that at the time the invention was made, creating a soundtrack using a game console was not well known to a person of ordinary skill in the art. Since existing game consoles did not lend themselves to customization, there was no thought of creating a soundtrack using a game console.

For at least these reasons, Applicant submits that claim 1 is allowable over Sano in view of Shih. Given that claims 2-13 and 45 depend from claim 1, those claims are also allowable for at least the same reasons.

Claim 12 is further allowable because neither Sano nor Shih, alone or in combination, disclose or suggest "the console application is further configured to associate the soundtrack with a particular user of the game console", as recited in claim 12. The Office Action states on pages 3-4 that outputting a soundtrack

associated with a specific user would have been well known. Applicant disagrees with this statement. Again, Applicant notes that the Office Action provides no support for this statement. Applicant submits that neither Sano nor Shih, alone or in combination, disclose or suggest the association of a soundtrack with a particular user of a game console, as recited in claim 12.

Claim 14 of the present application recites:

A game console, comprising:
a memory; and
a processor coupled to the memory, the processor being configured to present a first user interface to facilitate selection of stored audio tracks used to create a soundtrack containing the selected audio tracks, the processor further configured to present a second user interface to facilitate playback of created soundtracks stored in the memory.

As discussed above with respect to claim 1, Sano fails to disclose or suggest selecting audio tracks to create a soundtrack containing the selected audio tracks. Further, Sano fails to disclose "a first user interface to facilitate selection of stored audio tracks used to create a soundtrack" and "a second user interface to facilitate playback of created soundtracks", as recited in claim 14. As discussed above, nothing in Sano discloses or suggests the selection of audio tracks or the creation of a soundtrack based on the selected audio tracks. Therefore, there is no reason for Sano to make any reference to user interfaces associated with these functions. Accordingly, Applicant submits that Sano fails to disclose or suggest the elements of claim 14.

The Office Action states on "Further, Sano discloses a second user interface to facilitate playback of soundtracks (col. 5, lines 6-8)." (Office Action, page 4, paragraph 2e). The cited portion of Sano (col. 5, lines 6-8) state "An amplifier 71 and a speaker 72 are connected to D/A converter 60 via lead lines. Configurations of these components are described schematically below." The cited language of Sano is unrelated to user interfaces. Applicant fails to see how the cited portion of Sano teaches or suggests the an interface of the type recited in claim 14.

The Office Action further states at page 4, paragraph 2e:

Sano does not explicitly disclose a first user interface. However, Shih discloses a first user interface to facilitate selection of stored audio tracks (paragraphs 0010 and 0048). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the first user interface to the game console of Sano in order to allow the player to select a specific favorite track.

As discussed above, paragraphs 0010' and 0048 of Shih were not contained in the Shih Provisional Application. Therefore, the Office Action cannot properly consider the content of paragraphs 0010 and 0048 because they are not prior art with respect to the present application. Accordingly, those paragraphs of Shih cannot be cited to correct the deficiencies of Sano. For at least these reasons, Applicant submits that neither Sano nor Shih, alone or in combination, disclose or suggest a first user interface to facilitate selection of audio tracks or a second user interface to facilitate playback of created soundtracks.

Therefore, Applicant submits that claim 14 is allowable over Sano in view of Shih. Given that claims 15-20 depend from claim 14, Applicant respectfully

submits that those claims are likewise allowable over Sano in view of Shih for at least the reasons discussed above.

Claim 46 of the present application recites:

A method comprising:
identifying a plurality of stored audio tracks accessible by a game console;
displaying at least a portion of the plurality of stored audio tracks to a user;
receiving information regarding audio tracks selected by the user; and
creating a soundtrack containing the audio tracks selected by the user.

As discussed above, Sano fails to disclose or suggest "receiving information regarding audio tracks selected by the user" or "creating a soundtrack containing the audio tracks selected by the user", as recited in claim 46. Further, Sano fails to disclose or suggest identifying and displaying stored audio tracks accessible by the game console. As discussed above, the Shih reference fails to correct the deficiencies of Sano. Accordingly, Applicant submits that neither Sano nor Shih, alone or in combination, disclose or suggest these elements of claim 46.

In rejecting claim 46, the Office Action merely states "As per claim 46-48, refer to discussions in claims 1 and 14-15 above." (Office Action, page 4, paragraph 2i). The Office Action fails to mention the limitations of claim 46 that are not found in claims 1 or 14-15, such as "identifying a plurality of stored audio tracks accessible by a game console" and "displaying at least a portion of the plurality of the plurality of stored audio tracks to a user". Thus, the Office Action has failed to properly reject the elements of claim 46.

For at least these reasons, Applicant respectfully submits that claim 46 is allowable over Sano in view of Shih. Given that claims 47-51 depend from claim

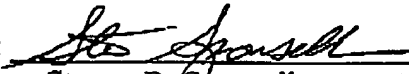
46, Applicant respectfully submits that those claims are likewise allowable over Sano in view of Shih for at least the reasons discussed above.

Conclusion

Claims 1-20 and 45-51 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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